

REMARKS

In the Office Action, the Examiner rejected claims 1-15, 26, and 27 and withdrew claims 16-25 from consideration. By the present Response, the Applicant canceled claims 3, 10, and 15 and amended claims 1, 4, 7, 13, 26, and 27. Upon entry of the foregoing amendments, claims 1, 2, 4-9, 11-14, 26, and 27 will remain pending in the present application. Applicants respectfully request reconsideration and allowance of all pending claims.

Objections to the Drawings

In the Office Action, the Examiner objected to the drawings for including the reference number 68 in the drawings without a corresponding description in the specification. The specification has been amended to include a description of the part numbered as 68. Accordingly, the Applicants respectfully request the Examiner to withdraw the foregoing objection to the drawings.

Rejections Under 35 U.S.C. § 102

In the Office Action, claims 1, 4-9, and 11-14 were rejected under 35 U.S.C. §102(b) as being anticipated by Copple et al. (U.S. Patent No. 5,380,136). A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). As discussed below, the present claims specifically recite a retaining portion *integral* with the washer portion, a *rotatably* retained fastener, and other unique features, which are absolutely devoid from the Copple et al. reference. Accordingly, the Examiner has not provided a *prima facie* case of anticipation.

As amended, independent claim 1 recites a “retaining portion *integral* with the washer portion,” and an internally threaded fastener “retained *rotatably* within assembly with the stemmed washer by the retaining portion.” (emphasis added) Independent claim

7, as amended, recites “a retaining skirt portion extending *integrally* from the washer portion and capturing the peripheral flange on the threaded nut to retain the threaded nut *rotatably* in assembly.” (Emphasis Added) Additionally, as amended, independent claim 13 recites “a retaining skirt portion extending *integrally* from the washer portion and capturing the fastener *rotatably* in assembly.” (Emphasis Added)

The Copple et al. reference is absolutely devoid of any such teaching or suggestion regarding *integral* and *rotatable* retainment of the fastener. Instead, Copple et al. teaches “an anchor nut 12” with “a degree of ‘float’ about the nut mount” to allow some “lateral and longitudinal movement.” Col. 5, lines 45-49. However, the anchor nut 12 is *incapable of rotational movement* relative to the remaining assembly. See Figs. 3-4; col. 6, line 33 - col. 7, line 32. Copple et al. also teach a nut mount 10 that is composed of multiple, *non-integral* parts, including a “mount base 13 and a flexible snap ring or retainer ring 14.” Col. 5, lines 58-60. Accordingly, independent claims 1, 7 and 13 are believed to be patentably distinct over the prior art and in condition for allowance. The corresponding dependent claims are also believed to be patentably distinct over the prior art and in condition for allowance based on their dependencies from independent claims 1, 7 and 13 and based on further distinguishing features recited in each respective claim.

In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102(b).

Rejections Under 35 U.S.C. § 103

In the Office Action, claims 2, 3, 10, 15, 26, and 27 were rejected under 35 U.S.C. §103(a) as being obvious over Copple et al. (U.S. Patent No. 5,380,136) in view of McKinlay (U.S. Patent No. 5,688,091).

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

As discussed above, the Copple et al. reference does not teach or suggest *rotatable* and *integral* retainment of a fastener, as recited in independent claims 1, 7, 13, 26, and 27. Instead, Copple et al. teach a *separate* retainer ring 14, which secures a longitudinally moveable anchor nut 12 in a *non-rotatable* configuration relative to the remaining assembly. See Figs. 3-4; col. 6, line 33-col. 7, line 32. The remaining references cited by Examiner fail to obviate the deficiencies of the Copple et al. reference.

In fact, the Copple et al. and McKinlay references teach away from one another and there is absolutely no motivation or suggestion to combine the references. Combining these references would produce an inoperable product, which has a *non-*

rotatable disclosed by Copple et al. and a *non-rotatable* bolt 12 disclosed by McKinlay. As discussed above, the nut 12 of Copple et al. is rotatably fixed, while the bolt 4 is rotatably into the nut 12 to secure the bolt 4 to the fixed nut 12. See Fig. 2; col. 5, lines 4-22. The McKinlay reference discloses the *direct opposite configuration* in which the nut 20 rotates, while the bolt 12 is fixed to the workpiece in a non-rotatable configuration. Col. 2, lines 22-33. The McKinlay reference specifically teaches a bolt 12 having a “conventional button-shaped head 18 to prevent being gripped by a wrench or pliers” (col. 2, lines 26-27). It is improper to combine references, such as the Copple et al. and McKinlay references, where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 281 U.S.P.Q. 769, 779 (Fed. Cir. 1983).

The Applicants also stress the lack of suggestion or motivation to combine the Copple et al. and McKinlay references. In fact, the modification proposed by Examiner would render the prior art invention unsatisfactory for its intended purpose and, therefore, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). First, the washer 34 disclosed by McKinlay is not a *stemmed* washer, as recited in the present claims. Neither the Copple et al. reference nor the McKinlay reference provide any motivation or suggestion to combine the *non-stemmed* washer 34 of McKinlay with the anchor nut mount 10 of Copple et al. Second, the nut and bolt configurations of Copple et al. and McKinlay are directly opposite and inoperable together. Copple et al. specifically teach a fixed nut and a rotatable bolt, while McKinlay teaches a fixed bolt and a rotatable nut. Accordingly, the Examiner has failed to provide evidence of suggestion or motivation to combine the references.

The Examiner also asserted that several features recited by the present claims “would have been obvious at the time the invention was made to a person of ordinary skill in the art.” Paper No. 5, pages 5-6. For example, the Examiner alleged that

rotatable retainment of a fastener, as recited in independent claims 1, 7, 13, 26, and 27, is “well-known” in the art. Essentially, the Examiner has taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being “well-known” in the art. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby seasonably traverse and challenge the Examiner’s use of Official Notice. Specifically, the Applicants respectfully request that the Examiner produce evidence in support of the Examiner’s position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the Copple et al. and McKinlay references, the Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly “well known” elements of the present claims, as discussed above, or withdraw the rejection.

In view of the foregoing amendments and remarks, independent claims 1, 7, 13, 26, and 27 are believed to be patentable over the cited references, taken alone or in combination. The remaining claims are also believed to be patentable over the cited references by way of their dependencies on independent claims 1, 7, and 13 and by way of further distinguishing features recited in each respective claim. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 (a).

Attachment

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned “VERSION WITH MARKINGS TO SHOW CHANGES MADE.”

CONCLUSION

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Date: August 1, 2002

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Tait R. Swanson", written over a horizontal line.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION

Please amend the specification by replacing the original paragraph at page 7, lines 6-13 with the following amended paragraph:

As the assembly is brought together, as illustrated in Figure 7, the internally threaded fastener 60 is lowered into the aperture formed by the ridge 64, as illustrated by arrow 66. The skirt is then deformed plastically, such as through a crimping or flaring operation, as illustrated by arrows 68, to secure the skirt within the stemmed washer. In the illustrated embodiment, skirt 62 is deformed so as to provide for free rotation of the fastener within the stemmed washer. Alternatively, the deforming operation performed on the skirt may be such as to fixedly secure the nut with relation to the stemmed washer to prevent their mutual rotation.

IN THE CLAIMS

Please cancel claims 3, 10 and 15.

Please amend the claims as follows:

1. (Amended) An internally threaded fastener assembly comprising:
a stemmed washer having a washer portion, a standoff portion integral with the washer portion and extending therefrom, and a retaining portion integral with the washer portion; and
an internally threaded fastener disposed adjacent to the washer portion and retained rotatably within ~~in~~ assembly with the stemmed washer by the retaining portion.

4. (Amended) The assembly of claim 1, wherein the standoff portion forms a hollow right cylinder.

7. (Amended) An internally threaded fastener assembly comprising:
a threaded nut having a lower peripheral flange; and
a base having a washer portion, a standoff portion extending from the washer portion, and a retaining skirt portion extending integrally from the washer portion and capturing the peripheral flange of the threaded nut to retain the threaded nut rotatably in assembly with the base.

13. (Amended) An internally threaded fastener assembly comprising:
an internally threaded fastener; and
a base having a washer portion, a standoff portion extending from the washer portion, and a retaining skirt portion extending integrally from the washer portion and capturing the fastener rotatably in assembly with the base.

26. (Amended) A fastener kit comprising:
a stemmed washer having a washer portion, a standoff portion integral with the washer portion, and a retaining portion integral with the washer portion;
an internally threaded fastener disposed adjacent to the washer portion and retained rotatably within ~~in~~ assembly with the stemmed washer by the retaining portion; and
an externally threaded fastener which mates with the internally threaded fastener.

27. (Amended) A fastened joint comprising:
a stemmed washer having a washer portion, a standoff portion integral with the washer portion, and a retaining portion integral with the washer portion;
an internally threaded fastener disposed adjacent to the washer portion and retained rotatably within ~~in~~ assembly with the stemmed washer by the retaining portion;

an externally threaded fastener which mates with the internally threaded fastener, the externally threaded fastener including a head; and

a compressible substrate joined between the standoff portion and the head of the externally threaded fastener.